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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Dayton, Ohio

Docket No. 9852.00

Application of

Wayne M. Doran

Serial No. 10/022,957

Filed: December 18, 2001

For: **ISSUING CERTIFIED CHECKS OVER THE INTERNET**

DEC 20 2007

Group Art Unit: 3621

Examiner: **John M. Winter**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on **August 30, 2007**. Authorization is given to charge deposit account number 14-0225 for the fee under 37 C.F.R. 1.17 for filing the Appeal Brief.

(1) REAL PARTY IN INTEREST

The present application is assigned to NCR Corporation of Maryland.

(2) RELATED APPEALS AND INTERFERENCES

None.

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(3) STATUS OF CLAIMS

The above-identified patent application was filed on December 18, 2001 with claims 1-16. In response to an Office Action mailed August 24, 2004, claims 17-20 are added. In response to a final Office Action mailed on February 25, 2005, Applicant proposed to cancel claims 1-20 and add new claims 21-40. In response to an Advisory Action mailed on May 27, 2005, an RCE was filed in which claims 1-20 were canceled and new claims 21-40 were added. In response to an Office Action mailed August 26, 2005, claims 22-29, 39, and 40 were amended, claims 31-37 were canceled, and new claims 41-47 were added. In response to an Office Action mailed February 15, 2006, claims 21, 29, and 30 were canceled, and claims 22, 23, 25, and 27 were amended. In response to an Office Action mailed June 29, 2006, claim 27 was canceled, and claim 28 was amended. In response to an Office Action mailed December 20, 2006, claims 22-26, 28, and 38-47 were canceled, and new claims 48-62 were added. In response to a final Office Action mailed on June 4, 2007, Applicant proposed to amend claims 48, 49, 51, 53, 54, 57, 58, 59, and 61. In response to an Advisory Action mailed on August 20, 2007, a Notice of Appeal was filed on August 30, 2007. Thus, claims 48-62 remain pending and stand rejected.

Claims 48, 49, 50, 53, 57, 58, 59, and 60 are being appealed and are attached as an appendix to this Appeal Brief.

(4) STATUS OF AMENDMENTS

No amendments were entered subsequent to the last final rejection which was mailed on June 4, 2007.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

Independent Claim 48

A computer implemented method by a financial institution 12, the method comprising, by a server 13 associated with the financial institution (page 3, line 19):

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receiving from a check payor 4 a request for a validation number yet to be generated and then associated with a check 50 to be presented from the check payor to a check payee 61 (page 3, lines 19-29; page 4, lines 16 and 17);

determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, lines 5 and 6);

generating a validation number 42 when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is randomly generated by the financial institution (page 4, line 8; page 7, lines 13 and 14); and

issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee (page 4, line 8 and lines 17-19).

Independent Claim 49

A computer implemented method by a financial institution 12, the method comprising, by a server 13 associated with the financial institution (page 3, line 19):

receiving from a check payor 4 a request for a validation number yet to be generated and then associated with a check 50 to be presented from the check payor to a check payee 61 (page 3, lines 19-29; page 4, lines 16 and 17);

determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, lines 5 and 6);

generating a validation number 42 when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is generated based upon at least some information associated with the check to be presented from the check payor to the check payee (page 4, line 8; page 7, lines 15-21); and

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issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee (page 4, line 8 and lines 17-19).

Independent Claim 53

A computer implemented method by a financial institution 12, the method comprising, by a server 13 associated with the financial institution (page 3, line 19):

receiving from a check payor 4 a request for a validation number yet to be generated and then associated with a check 50 to be presented from the check payor to a check payee 61 (page 3, lines 19-29; page 4, lines 16 and 17);

verifying that the request was made by a party authorized to write checks on the account (page 4, lines 1-4);

verifying that the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, lines 5 and 6);

generating a validation number 42 when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, line 8); and

issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee (page 4, line 8 and lines 17-19).

Independent Claim 57

A method by a financial institution 12, the method comprising, by a server 13 associated with the financial institution (page 3, line 19):

receiving from a check payor 4 over the Internet (i) a request for a validation number yet to be generated and then associated with a check 50 to be presented from the

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check payor to a check payee 61, and (ii) a monetary amount of the check (page 3, lines 19-29; page 4, lines 16 and 17);

determining if an account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, lines 5 and 6);

generating a validation number 42 when the account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, line 8);

issuing the generated validation number to the check payor over the Internet to allow the check payor to associate the issued validation number with the check to be presented from the check payor to the check payee (page 4, line 8 and lines 17-19);

receiving a proposed character sequence from the check payee over the Internet (page 4, line 25 to page 5, line 9);

comparing the proposed character sequence received from the check payee with the validation number which has been generated and issued to the check payor (page 5, lines 10-13); and

issuing a confirmation signal to the check payee over the Internet to confirm that the proposed character sequence is valid based upon the comparison of the proposed character sequence with the validation number (page 7, lines 5-11).

Independent Claim 58

A method by a financial institution 12, the method comprising, by a server 13 associated with the financial institution (page 3, line 19):

receiving from a check payor 4 over the Internet (i) a request for a validation number yet to be generated and then associated with a check 50 to be presented from the check payor to a check payee 61, and (ii) a monetary amount of the check (page 3, lines 19-29; page 4, lines 16 and 17);

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determining if an account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, lines 5 and 6);

generating a validation number 42 when the account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is randomly generated by the financial institution (page 4, line 8; page 7, lines 13 and 14); and

issuing to the check payor over the Internet the generated validation number to allow the check payor to associate the validation number with the check to be presented from the check payor to the check payee (page 4, line 8 and lines 17-19).

Independent Claim 59

A method by a financial institution 12, the method comprising, by a server 13 associated with the financial institution (page 3, line 19):

receiving from a check payor 4 over the Internet (i) a request for a validation number yet to be generated and then associated with a check 50 to be presented from the check payor to a check payee 61, and (ii) a monetary amount of the check (page 3, lines 19-29; page 4, lines 16 and 17);

determining if an account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee (page 4, lines 5 and 6); and

generating a validation number 42 when the account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is generated based upon at least some information associated with the check to be presented from the check payor to the check payee (page 4, line 8; page 7, lines 15-21); and

issuing to the check payor over the Internet the generated validation number to allow the check payor to associate the validation number with the check to be presented from

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the check payor to the check payee (page 4, line 8 and lines 17-19).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

An issue presented for review is whether each of claims 48, 49, 50, 53, 57, 58, 59, and 60 is patentable under 35 U.S.C. Section 103(a) over U.S. Patent No. 5,884,288 to Chang et al. (referred to herein as "Chang") in view of U.S. Patent No. 6,754,640 to Bozeman and in further view of U.S. Patent No. 5,903,878 to Talati et al. (referred to herein as "Talati").

(7) ARGUMENT

Arguments for Each of Claims 48, 49, 50, 53, 57, 58, 59, and 60

First, Applicant would like to point out that the preamble of each of claims 48, 49, 50, 53, 57, 58, 59, and 60 recites:

"A computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution"

Applicant would like to also point out that each of 48, 49, 50, 53, 57, 58, 59, and 60 recites, inter alia:

"generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee"

In the present application, it is a server associated with a financial institution, such as a bank, which is generating a validation number when a determination is made that an account contains sufficient funds (*emphasis of underlining added by Applicant*).

With respect to the above-identified claim language recited in the preamble and body of each of claims 48, 49, 50, 53, 57, 58, 59, and 60, Applicant notes that the Examiner refers to column 7, line 45 to column 8, line 16 of the specification of Talati. In this regard, Applicant would like to respectfully point out that there is no mention at all in this portion of

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the specification of Talati of any “validation number” being generated by a bank or financial institution in response to a determination being made that an account contains sufficient funds. Applicant would also like to respectfully point out that the UTID in Talati is a “unique transaction identifier” which is generated by the purchaser in the transaction, and not by the bank or financial institution (see Figure 5; column 2, line 55 to column 3, line 3; and column 5, lines 50-67 of the specification of Talati). Note that it is the processor 70 of the client or purchaser 50 which is generating the UTID Talati.

Second, Applicant would like to point out that each of claims 48, 49, 50, 53, 57, 58, 59, and 60 recites, inter alia, that the financial institution issues the generated validation number to the check payor (over the Internet, for example) to allow the check payor to associate the issued validation number with the check to be presented from the check payor to the check payee. In this regard, Applicant submits that since Talati does not even disclose the financial institution generating a validation number in response to a determination being made that an account contains sufficient funds, Talati cannot disclose the financial institution issuing such a validation number to a check payor.

If the Examiner continues to reject claims 48, 49, 50, 53, 57, 58, 59, and 60 of the present application by applying Talati, it is respectfully requested that the Examiner specifically point out where the following is disclosed:

- (i) a financial institution generating a validation number when a determination is made that an account contains sufficient funds; and
- (ii) the financial institution issuing the generated validation number to a check payor to allow the check payor to associate the validation number with a check to be presented from the check payor to a check payee.

Absent an adequate explanation, it is respectfully submitted that the rejection of each of claims 48, 49, 50, 53, 57, 58, 59, and 60 is improper and, therefore, should be withdrawn.

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Additional Arguments for Each of Claims 48 and 58

In addition to the reasons hereinabove, each of claims 48 and 58 is allowable also for the following reasons.

Applicant would like to point out that each of claims 48 and 58 recites, inter alia:

“wherein the validation number is randomly generated by the financial institution”

Applicant submits that since Talati does not even disclose the financial institution generating a validation number in response to a determination being made that an account contains sufficient funds, Talati cannot disclose that the validation number is randomly generated by the financial institution.

Additional Arguments for Each of Claims 49 and 59

In addition to the reasons hereinabove, each of claims 49 and 59 is allowable also for the following reasons.

Applicant would like to point out that each of claims 49 and 59 recites, inter alia:

“wherein the validation number is generated based upon at least some information associated with the check to be presented from the check payor to the check payee”

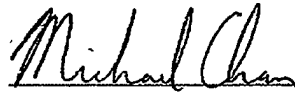
Applicant submits that since Talati does not even disclose the financial institution generating a validation number in response to a determination being made that an account contains sufficient funds, Talati cannot disclose that the validation number is generated based upon at least some information associated with the check to be presented from the check payor to the check payee.

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Conclusion

In view of the forgoing reasons, it is clear that the rejection of claims 48, 49, 50, 53, 57, 58, 59, and 60 under 35 U.S.C. Section 103 (a) is improper and, therefore, should be withdrawn. It is respectfully requested that the Board reverse the rejection of claims 48, 49, 50, 53, 57, 58, 59, and 60.

Respectfully submitted,



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(8) CLAIMS APPENDIX

48. A computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee;

determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is randomly generated by the financial institution; and

issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee.

49. A computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee;

determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is generated based upon at least some information associated with the check to be presented from the check payor to the check payee; and

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issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee.

50. A computer implemented method according to claim 49, wherein the at least some information associated with the check comprises:

- (i) a date of the check;
- (ii) a serial number of the check;
- (iii) an account number of the account;
- (iv) a monetary amount of the check;
- (v) a payee of the check;
- (vi) symbols identifying a drawee financial institution which maintains custody of the account; and
- (vii) a Uniform Resource Locator (URL).

53. A computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee;

verifying that the request was made by a party authorized to write checks on the account;

verifying that the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee; and

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issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee.

57. A method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor over the Internet (i) a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee, and (ii) a monetary amount of the check;

determining if an account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

generating a validation number when the account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

issuing the generated validation number to the check payor over the Internet to allow the check payor to associate the issued validation number with the check to be presented from the check payor to the check payee;

receiving a proposed character sequence from the check payee over the Internet;

comparing the proposed character sequence received from the check payee with the validation number which has been generated and issued to the check payor; and

issuing a confirmation signal to the check payee over the Internet to confirm that the proposed character sequence is valid based upon the comparison of the proposed character sequence with the validation number.

58. A method by a financial institution, the method comprising, by a server associated with the financial institution:

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receiving from a check payor over the Internet (i) a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee, and (ii) a monetary amount of the check;

determining if an account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee;

generating a validation number when the account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is randomly generated by the financial institution; and

issuing to the check payor over the Internet the generated validation number to allow the check payor to associate the validation number with the check to be presented from the check payor to the check payee.

59. A method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor over the Internet (i) a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee, and (ii) a monetary amount of the check;

determining if an account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee; and

generating a validation number when the account associated with the check payor contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee, wherein the validation number is generated based upon at least some information associated with the check to be presented from the check payor to the check payee; and

issuing to the check payor over the Internet the generated validation number to

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allow the check payor to associate the validation number with the check to be presented from the check payor to the check payee.

60. A method according to claim 59, wherein the at least some information associated with the check comprises:

- (i) a date of the check;
- (ii) a serial number of the check;
- (iii) an account number of the account;
- (iv) a monetary amount of the check;
- (v) a payee of the check;
- (vi) symbols identifying a drawee financial institution which maintains custody of the account; and
- (vii) a Uniform Resource Locator (URL).

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(9) EVIDENCE APPENDIX

None.

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(10) RELATED PROCEEDINGS APPENDIX

None.